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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,327	09/24/2003	Toshiki Taguchi	Q77655	2308
23373	7590	03/13/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KLEMANSKI, HELENE G	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

✓

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/668,327	<b>Applicant(s)</b> TAGUCHI, TOSHIKI	
	<b>Examiner</b> Helene Klemanski	<b>Art Unit</b> 1755	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 01 March 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) \_\_\_\_\_.
13. ☐ Other: \_\_\_\_\_.

  
 Helene Klemanski  
 Primary Examiner  
 Art Unit: 1755

Continuation of 11. does NOT place the application in condition for allowance because: applicants arguments with respect to the provisional ODP are not persuasive since it is the examiner's position that the phthalocyanine dye of 10/806424 broadly encompasses the phthalocyanine dye of the instant claims. Specifically, the claims of 10/806424 broadly disclose a phthalocyanine dye containing -SO-, -SO<sub>2</sub>-, -CO- and or -CO<sub>2</sub>- groups and applicants present claims are drawn to a phthalocyanine dye also containing these groups. The examiner merely pointed to the specification to provide support for the claims. MPEP 804 (II)(B)(1) states that "those portions of the specification which provide support for the claims may also be examined and considered" when determining an ODP rejection. See also *In re Vogel*, 164 USPQ 619, 622. Also, the allowed claims of 10/806424 still encompass the present claims since they still include a phthalocyanine dye containing the above groups. See allowed claims 3, 7 and 14. Furthermore, applicants arguments with respect to the Kenworthy et al. reference are not persuasive since the Kenworthy et al. reference does specifically disclose that the phthalocyanine dye can be in the form of an alkali metal salt such as lithium, sodium or potassium as well as ammonium or substituted ammonium salts (see col. 5, lines 5-26 and claims 1, 4 and 5) and does suggest that the amount of ions in the ink is low since the sodium cations on the phthalocyanine dye are replaced with another cation such as ammonium (see col. 11, line 65-col. 12, line 6). Applicants only example in the specification shows the replacement of sodium cations with lithium cations which rendered the ink with a total amount of cations as claimed below 0.5 wt%. Therefore, it is the examiner's position that the ink of Kenworthy et al. would have a total amount of cations as claimed by applicants in an amount of 0.5 wt% or less when the sodium cations are replaced with lithium as suggested by Kenworthy et al. absent a showing to the contrary.